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EXAMINER

LOEWE, ROBERT S

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

In response to applicant's argument that the addition of component (B) of instant claim 1 improves the adhesive strength and reduces the amount of tackifier needed is noted. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The reason for adding component (B) as taught by Watabe et al. to the compositions as taught by Toda et al. is different than what is being argued by the Applicants. Specifically, as noted in the previous Office action, a person having ordinary skill in the art would have been motivated to add the low molecular weight oxyalkylene polymers [i.e., component (B) of the instant claims] as taught by Watabe et al. into the compositions taught by Toda et al. and would have been motivated to do so since Watabe et al. teaches that the low molecular weight oxyalkylene polymers are effective plasticizers and display low migration, allowing the compositions to be pliable (paragraphs 0003 and 0007 of Watabe et al.) Watabe et al. further teaches that the low molecular weight oxyalkylene polymers are superior plasticizers when compared to other known plasticizers such as phosphoric acid esters, and aromatic carboxylic acid esters (paragraphs 0006 and 0007). Toda et al. teaches the addition of plasticizers which include the same phosphoric acid esters and aromatic carboxylic acid esters plasticizers as taught by Watabe et al. (paragraph 0023 of Toda et al.).

Applicants further argue that the comparative examples 1 and 2 of the instant application resemble the compositions as taught by Toda et al. Applicants further argue that the addition of component (B) achieves a very high adhesive strength, which is unexpected. However, any

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showing of unexpected results must be commensurate in scope with the base claim. Based on the data provided in the working examples, this does not appear to be the case. Specifically, component (A) of instant claim 1 is claimed to have a molecular weight range of from 15,000 to 100,000; however, the specific examples which satisfy this limitation have molecular weights of 26,000 and 31,000. Moreover, component (B) of instant claim 1 is claimed to have a molecular weight range of from 500 to 15,000; however, the specific examples which satisfy this limitation have molecular weights of 1,200 and 4,000. Further, only one amount of tackifier resin is employed in the working examples (50 parts by weight). Last, it appears only comparative example 1 can be directly compared to working examples 1-3 since comparative example 2 employs additional solvent and comparative example 3 employs a different amount of tackifier resin.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT LOEWE whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/R. L./

Examiner, Art Unit 1796

8-Apr-09